

## REMARKS

The Official Action of June 7, 2006 noted that Applicant's May 4, 2007 and May 16, 2007 supplemental replies to the January 8, 2007 Official Action had not been entered and objected to claims 2, 20, and 23 for certain informalities noted on pages 3-4 of the Action. Claim 2 was rejected as being indefinite for failing to particularly point out and claim Applicant's invention under 35 U.S.C. 112, second paragraph. Claims 19 and 24-27 were rejected under 35 U.S.C. 102 as being anticipated by the Perren, *et al.* patent ("Perren"). Claims 19-21, 24, and 26 were rejected under 35 U.S.C. 103 as being obvious over the combination of the Ralph '731 or '291 patents in view of Muhanna, and claims 22-23 were rejected under that same section of the Statute as being obvious over the combination of the two Ralph patents and Muhanna in view of the Haldemann patent. All of these objections/rejections are traversed, and in accordance with the requirements of 37 C.F.R. 1.111(b), the basis for traversing these rejections is set out below.

Claims 2, 20 (actually, claim 21), and 23 have been amended to remedy the informalities noted in the Action. Reconsideration and withdrawal of the objections to claims 2, 20/21, and 23 is respectfully requested in light of these amendments.

Responsive to the §112 rejection of claim 2, the claim has been amended after it was discovered (as set out in the Supplemental Response to Official Action of January 8, 2007, which was not entered) that the references to the height and width of the implant had been inadvertently reversed in claim 2. A review of the specification, particularly page 6, lines 16-24, revealed the source of the confusion. Specifically, the specification referred to the dimension of the sides 32 defining the height of the implant of Applicant's invention as being less than the dimension of the sides 34 defining the width of the implant. However, the figures show that this explanation of the structure of the implant is "backwards" and that the height of the implant is **greater than** the width of the implant. It was also discovered that this same paragraph of the specification referred to the implant of the present invention as being shown at reference numeral 20 when in fact the drawings show the implant at reference numeral 22. Applicant has therefore amended page 6 of the specification and claim 2 to conform them to the structure shown in the figures.

Applicant submits that these amendments to the specification and to claim 2 do not constitute new matter because the structure of the implant 22 utilized in Applicant's method is clearly shown in the figures and because those figures are properly labeled with the correct reference numerals. Because the figures are correctly numbered, the above amendments merely substitute the reference numerals shown in the figures, and clear references to the height and the width of implant 22, for the incorrect reference numerals and references to height and width in the specification as filed. These errors were inadvertent, and one skilled in the art would clearly

recognize that the figures and the description of those figures were inconsistent such that these amendments to the specification and to claim 2 are corrections, not additions, to the captioned application. As a further indication of how these amendments do not constitute new matter, reference is made to page 8, lines 5-10 of the specification, stating (correctly) that:

“implant 22 is inserted into the disk space with the wide sides 32 (so that the height of implant 22 is of minimal dimension) proximate the bodies of the adjacent vertebrae and rotated in the disk space by approximately 90° using the applicator so that the minimally-dimensioned sides 34 are proximate the bodies of the adjacent vertebrae so as to maximize the height of implant 22 in the disk space.”

As can be seen from this quotation from the specification, the above amendments to page 6 of the specification and to claim 2 are consistent not only with the drawings but also with the explanation of the structure and function of the implant of the present invention set out elsewhere in the specification and therefore do not constitute new matter. Entry of the above amendment to the specification and the amendments to claim 2 is therefore respectfully requested.

With regard to the rejection of claim 19 under §102 over Perren, Applicant appreciates the clarification of the basis for the rejection set out in the section of the Action titled “Response to Arguments” and has amended the claim to recite that only a portion of the intervertebral disk is removed. However, Applicant has not amended claim 2 (the other independent claim) in this same fashion because, if claim 2 was amended in this same manner, it might not be construed broadly enough at some later date to cover a party that removes the entire disk. In fact, claim 2 makes no reference to removing the intervertebral disk (regardless of whether a portion or the entire disk is removed) such that it is Applicant’s intention that this amendment to claim 19 have no relevance or effect on claim 2. Reconsideration and withdrawal of the §102 rejection of claim 19 over Perren is respectfully requested in light of the above amendment to that claim.

Because they are dependent upon a main claim that is not anticipated by either of the Perren or Ralph ‘291 patents, claims 24-27 are also allowable. In addition, each of claims 24-27 recites subject matter that is not disclosed in Perren or Ralph ‘291. For instance, because neither patent discloses an insert mounted to and biased away from the implant, neither can disclose a spring for biasing an insert away from the implant as recited in claim 24 or restraining the insert until after the implant is inserted into the disk space as recited in claim 25. Similarly, neither patent discloses an insert comprised of a springy, compressible material as recited in claim 26. Reconsideration and withdrawal of the §102 rejection of those claims is respectfully requested in light of these differences between the claims and the cited Perren and Ralph ‘291 patents.

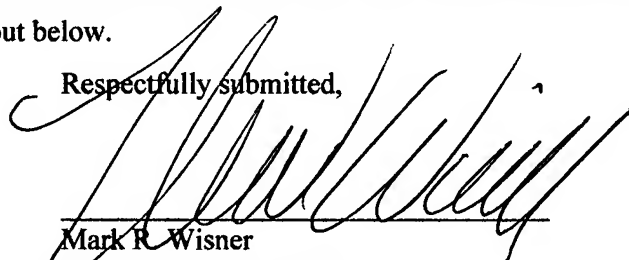
The §103 rejection of claims 19-21, 24, and 26 is also respectfully traversed because none of the cited references teach a method involving removal of only a portion of the disk.

These claims are also allowable because, as previously noted by Applicant, the Ralph patents do not teach or suggest biasing an insert that is mounted to an implant away from the implant after that device is introduced into the intervertebral space as recited in claim 19. To establish a proper *prima facie* showing of the obviousness of a claim requires, *inter alia*, that all the elements of the claim be disclosed in the prior art; in the absence of this claimed element, the §103 rejection of claim 19 is improper. Reconsideration and withdrawal of the §103 rejection of claim 19 over the Ralph patents is therefore respectfully requested.

Claims 22-23, also rejected under §103, are dependent on claim 19, which recites the removal of only a portion of the intervertebral disk, and that method is not disclosed in the cited references. Claims 22-23 further define over the cited references because, as Applicant has previously noted, the device disclosed in Muhanna is intended to replace the intervertebral disk such that there does not appear to be any reason to utilize a medical grade adhesive as suggested near the center of page 6 of the Action. It is therefore respectfully submitted that the Action fails to establish a proper *prima facie* showing of the obviousness of the differences between the method claimed in claims 22-23 and the cited references because the cited references do not teach or suggest the modification asserted in the Action. Reconsideration and withdrawal of the rejection of claims 22-23 is respectfully requested.

New claims 28 – 35 have been added to more completely claim that which Applicant regards as his invention. Entry of the above amendments and new claims, consideration of the remarks set out herein, allowance of the claims, and passage of the application to issuance are all respectfully requested. In the unforeseen event that there are questions and/or issues yet to be answered in this application, it is respectfully requested that Applicant's Attorney be contacted at the address and phone number set out below.

Respectfully submitted,



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